

REMARKS

Claim 18 stands rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants have amended the claim to indicate that the claimed program is embodied on a non-transitory computer-readable medium as suggested by the Examiner, thereby overcoming this rejection. Claim 18 is therefore allowable.

Claims 1, 3-6, 11, 12, 15, and 17-20 stand rejected under 35 U.S.C. § 103(a) over Ueda (U.S. Patent No. 6,538,764) in view of Hino (U.S. Patent No. 7,268,902). Applicants respectfully traverse this rejection. Neither Ueda nor Hino, alone or in combination, discloses or suggests all of the features recited in applicants' claim 1.

More specifically, the Examiner has cited CPU 12, depicted in Ueda's Fig. 1, as disclosing the "judgment unit that judges, prior to commencement of the image processing, whether the image data is stored in the storage unit," recited in applicants' claim 1. The Examiner further asserted that "The first judging means judges whether or not the intermediate code information corresponding to one page has been stored in the first storage area. Column 3, lines 51- 60 and Column 27, lines 41- 56." Applicants respectfully submit that the Examiner has misconstrued the disclosure of Ueda.

The claimed judgment unit "judges, prior to commencement of the image processing, whether *the image data* is stored in the storage unit." As shown in Fig. 1, the judgment unit, which is included in the central control unit 120 of the claimed printing apparatus, judges whether the desired image data for printing is currently stored in the storage unit – i.e. the volatile memory 130. If the judgment unit judges that the desired image data exists in the volatile memory 130, the printing system immediately processes that data for printing. If the judgment unit judges that the desired image data does not exist in the volatile memory 130, the central control unit 120 commands a retrieval of that data from the external storage apparatus – the mail server 200.

In contrast — and as explained on page 5 of the Appeal Brief filed on July 14, 2010, and on page 9 of the amendment filed on March 15, 2010 — the first judging means of Ueda cannot

possibly correspond to the claimed judgment unit of the present invention because it does not determine whether "the image data" is stored in the storage unit. The first judging means of Ueda determines whether the intermediate code memory 501 has overflowed with the one-page intermediate code information, rather than whether "the image data" that is currently desired by the printing system for printing is stored in the storage unit. In other words, the first judging means of Ueda only functions as a checking mechanism to determine whether the intermediate code memory 501 is full or not, whereas the claimed judgment unit functions as a comparison mechanism to determine whether the stored information in the storage unit corresponds to "the image data" that is currently desired by the printing system. Without an ability to compare what is stored in the storage unit to the image data desired for printing, the first judging means of Ueda cannot correspond to the claimed judgment unit.

Additionally, on pages 4-5 of the current action, the Examiner concedes that:

Ueda '764 does not expressly disclose a transmission unit that transmits the acquired image data to the external apparatus so that the transmitted image data is stored in the storage apparatus thereof while the storage unit stores the acquired image data; second data acquiring unit that acquires the image data from the external apparatus if the judgment unit judges negatively, and an image processing unit that executes the image processing using the image data stored in the storage unit if the judgment unit judges positively, and executes the image processing using the image data acquired by the second data acquiring unit if the judgment unit judges negatively.

The Examiner instead relies on Hino's alleged disclosure of these features.

More specifically, Hino does not disclose or suggest "a transmission unit that transmits the acquired image data to the external apparatus so that the transmitted image data is stored in the storage apparatus thereof while the storage unit stores the acquired image data," as recited in claim 1. While the Examiner has identified the protocol controller 1101 of Hino as disclosing this feature, the Examiner appears to have misinterpreted the disclosure of Hino. Hino states at col. 5, lines 58-65, that:

The protocol controller 1101 has a function for making the communications with the outside by analyzing and transmitting a network protocol. For example, when the HTTP (Hyper Text Transfer Protocol) is used, it acquires the document indicated by the URI or transmits the information to the Web server.

Contrary to the Examiner's assertion, this passage does not disclose that the protocol controller 1101 ever transmits acquired image data to an external apparatus as claimed. Instead, the protocol controller 1101 either receives image data or transmits URL information to a web server in order to acquire the desired image data. To the extent that the above quoted disclosure may be ambiguous, it is important to consider that Hino does not disclose or suggest any reason why the protocol controller 1101 would transmit acquired image data to an external apparatus. Because there is no reason for such a transmission, any ambiguity in the disclosure is resolved. Claim 1 is therefore allowable.

Hino also fails to disclose or suggest "an image processing unit that executes the image processing using the image data stored in the storage unit if the judgment unit judges positively, and executes the image processing using the image data acquired by the second data acquiring unit if the judgment unit judges negatively," as recited in claim 1. While the Examiner is correct that process steps 602 is a positive/negative decision step and that step 609 is a printing step, this does not disclose or suggest the features of claim 1. Regardless of the outcome of step 602, the data conversion step 608 is performed on data stored in the page memory 1105, and print step 609 prints the converted data. Hino does not disclose or suggest that the resources collected in step 607 are not then stored in the same memory as the original image data is stored. Accordingly, the image processing in steps 608 and 609 is executed using the image data stored in page memory 1105 regardless of the decision made in step 602. Claim 1 is therefore allowable.

Because neither Ueda nor Hino discloses or suggests all of the features of claim 1, it would not have been obvious to one skilled in the art to modify either reference to achieve applicants' claimed invention. Claim 1 is allowable for at least the above reasons. Claims 17 and 18 recite features substantially similar to those of claim 1 discussed above, and are allowable for at least the

same reasons as claim 1. Claims 3-6, 11, 12, 15, 19 and 20 are allowable due at least to their respective dependencies.

Additionally, one skilled in the art would not have been motivated to combine either Ueda or Hino with any reference in which the printer sends acquired data from the printer. Ueda is directed to a system in which a host computer transfers printing data — one page at a time — to a printer. The printer then prints the single page before receiving the next page of printing data. There would be no benefit or reason for one skilled in the art to try and modify the device of Ueda to send each page of printing data back to the host computer, to then determine if the printer had saved image data, and to then include a separate data acquiring unit to re-acquire the printing data from the host computer, and then to execute image processing based on the printing data acquired through the separate data acquiring unit. The addition of such features serves no purpose in the system of Ueda. Consequently, it would not have been obvious to one skilled in the art to modify Ueda as suggested by the Examiner. Similarly, the system of Hino relates to a printer that collects data from other sources. There does not appear to be any reason that one skilled in the art would alter the system of Hino to transmit acquired image data. Claims 1, 3-6, 11, 12, 15, and 17-20 are allowable for at least this reason as well.

Claims 2, 7, 10, 13, 14, and 22 stand rejected under 35 U.S.C. § 103(a) over Ueda, Hino, and Kajita (U.S. Patent No. 6,069,706). Applicants respectfully traverse this rejection. Kajita fails to overcome the deficiencies of Ueda and Hino discussed above. Claims 2, 7, 10, 13, 14 and 22 are therefore allowable due at least to their respective dependencies.

Claims 8, 9, 16, and 22 stand rejected under 35 U.S.C. § 103(a) over Ueda, Kajita, and Iwazaki (U.S. Patent No. 6,687,742). Applicants respectfully traverse this rejection.

The Examiner has not cited either Kajita or Iwazaki as disclosing the features of claim 1 that the Examiner conceded are not disclosed by Ueda. Accordingly, the Examiner has not even alleged that the combination of Ueda, Kajita, and Iwazaki (without Hino) discloses all of the features recited

in applicants' claim 1, or that the combination renders applicants' claim 1 obvious. Claim 1 is therefore allowable due at least to the Examiner's failure to provide a *prima facie* showing of obviousness. Claims 8, 9, 16, and 22 all depend from allowable claim 1 and are therefore allowable due at least to their respective dependencies.

In view of the above, each of the claims in this application is in condition for allowance. Accordingly, the Examiner is requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief, including extensions of time, and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no.
325772034700.

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